

REMARKS

INTRODUCTION:

As a point of clarification, item 4 on page 1 of the Office Action indicates that claims 45-68 are pending. However, in view of the Amendment of March 23, 2005, withdrawn claims 52 and 61 were cancelled without prejudice or disclaimer. Therefore, claims 45-51, 53-60, and 62-69 are pending and under consideration. Reconsideration is requested.

REJECTION UNDER 35 U.S.C. §112:

A. Claim 51 is compliant with 35 U.S.C. §112, first paragraph

On page 2 of the Office Action, the Examiner rejects claim 51 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed and reconsideration is requested.

As a general matter, in order to establish a prima facie case for a rejection under 35 U.S.C. §112, first paragraph, the Examiner must provide evidence as to why one of ordinary skill in the art would believe that the disclosure does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter. E.g., In re Alton, 37 USPQ2d 1578 (Fed. Cir. 1996) (prima facie case established by specifically pointing out which example in the specification does not support the claims), In re Gosteli, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (prima facie burden met where Examiner pointed out numerous differences between claimed subject matter and the written description); and MPEP 2163. However, where the Examiner does not point out differences rendering the claims sufficiently unclear to not convey possession of the invention or even what embodiments do not support the recited invention, the Examiner has not met this burden.

In rejecting claim 51, the Examiner asserts that the amended feature of "the file being prepared by and stored on the reproduction apparatus prior to transmission to the server" is not supported by the original specification. The Examiner does not indicate how such a feature is not supported in the claims as originally presented or which embodiments in the specification lack such a description sufficient to warrant a rejection under 35 U.S.C. §112, first paragraph.

Moreover, original claim 9, which has since been cancelled, similarly recited "a server to receive an identifier," "the identifier having been stored on the reproduction apparatus." As noted in MPEP 2163(I)(A), "[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." It is respectfully submitted that the Examiner's analysis has not overcome this strong presumption.

Lastly, while not limited thereto, an embodiment of the invention shown in FIG. 4 provides sufficient support for the claimed feature. Specifically, in operation 402, an ISRC code is stored in a Cookie file. When additional information is requested, a connection is made to an additional information service server system in operation 405, and the ISRC code is sent to server in operation 406. Additional clarifying detail on this specific embodiment is found in paragraphs 0030 through 0032. Since the Examiner's analysis does not appear to reflect at least this embodiment in the context of the broader invention, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

B. Claims 45-67 are compliant with 35 U.S.C. §112, second paragraph

On pages 2-3 of the Office Action, the Examiner rejects claims 45-67 under 35 U.S.C. § 112, second paragraph, since the Examiner asserts that the term "additional information" is an indefinite relative term. This rejection is respectfully traversed and reconsideration is requested.

As an initial point of clarification, claims 52 and 61 were previously cancelled without prejudice or disclaimer. Therefore, it is respectfully submitted that the rejection is deemed moot with respect to these claims.

On pages 9-10 of the Office Action, the Examiner clarifies the rejection by noting that paragraph 0004 is not adequate in defining what is being encompassed by the recited "additional information." The Examiner further asserts that there is insufficient explanation of what additional information could be retrieved to be used in conjunction with the contents since the applicants are using "vague and nebulous terms."

As a general matter, the mere fact that the applicants choose a broad term does not in and of itself constitute evidence of indefiniteness. As noted in MPEP 2173.04, "[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)." As such, it is incumbent on the Examiner to provide evidence of indefiniteness using the factors outlined in MPEP 2173.02 in order to maintain a prima facie case for indefiniteness.

In rejecting the claims, the Examiner asserts that the term "additional information" is not defined in the claims and that the specification does not provide a standard for ascertaining the scope of the invention. While acknowledging that at least paragraph 0004 defines certain types of additional information, the Examiner does not provide evidence as to why the term "additional information," with or without reference to this paragraph, would be so un-definable or un-ascertainable to one of ordinary skill in the art as to warrant a rejection under 35 U.S.C. §112.

Further, the Examiner has not provided evidence of conflicting definitions in the art, whether the level of skill in the art is sufficiently low that one of ordinary skill in the art would be unable to understand the recited terms (with or without reference to the specification) as set forth

in the claims so as to show such indefiniteness. Therefore, even assuming *arguendo* that the terms "contents" and "additional information" are vague and nebulous, this bare assertion that the terms are vague and nebulous is insufficient to maintain a rejection under 35 U.S.C. §112, second paragraph without evidence that the terms are so vague and nebulous as to be indefinite when analyzed using the factors set forth in MPEP 2173.02.

Additionally, it is again noted that, while not restricted thereto, there is a sufficient description of the terms contents and additional information in paragraphs 0004, 0005, and 0006.

Lastly, in regards to claims 65-67, while not restricted thereto, there is a description of an embodiment of reproducing the additional information without reproducing the contents in paragraph 0032 in regards to optional operation 403. It is respectfully submitted that, with or without reference to these specific embodiments, the factors of MPEP 2173.02 are satisfied and compliance with 35 U.S.C. §112, second paragraph is shown and that the Examiner has not provided sufficient evidence of indefiniteness to maintain a rejection under 35 U.S.C. §112, second paragraph of these claims without such analysis.

Therefore, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 45-51, 53-60, and 62-67 under 35 U.S.C. §112, second paragraph.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action at pages 3-5, the Examiner rejects claims 51 and 53-57 under 35 U.S.C. §102 in view of Levy et al. (U.S. Patent No. 6,505,160). This rejection is respectfully traversed and reconsideration is requested.

By way of review, claim 51 recites, among other features, "a server for receiving a file including an identifier of predetermined contents from a reproduction apparatus for reproducing the contents, the file being prepared by and stored on the reproduction apparatus prior to transmission to the server, retrieving one of the additional information items corresponding to the contents identifier from the additional information data base, and transmitting the retrieved one additional information item to the reproduction apparatus," "wherein the contents identifier is recorded in at least one recording medium on which the contents are recorded."

In contrast, Levy et al. discloses retrieving a contents ID, such as an International Standard Recording Code (ISRC) directly from the contents, and transmitting the retrieved ID to a server 1 for use in retrieving linked data stored therein. (Col. 3, lines 24-29, col. 4, lines 33-67; FIG. 1). There is no suggestion that the ID is stored in a decoder using a file or other device, and that the stored ID is what is received by the server 1.

On page 10 of the Office Action, the Examiner clarifies that the decoder in Levy et al. inherently stores the ID in order to transmit the ID. However, the Examiner does not provide an explanation as to why, in each and every instance, the decoder in Levy et al. necessarily would have to store the ID prior to transmitting the ID. Generally, where the Examiner relies upon the theory of inherency, the Examiner is required to provide extrinsic evidence that the features are necessarily present in the reference. As noted in MPEP 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (emphasis in original). Since the Examiner has not provided evidence that the decoder shown in Levy et al. necessarily stores the ID prior to transmission, it is respectfully submitted that the Examiner has not provided sufficient evidence to rely on Levy et al. inherently disclosing such a feature as set forth in the Office Action. As such, it is respectfully submitted that Levy et al. does not disclose or suggest the invention recited in claim 51.

Claims 53-57 are deemed patentable due at least to their depending from claim 51.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 5-9, the Examiner rejects claims 45-50 and 58-60, and 62-68 under 35 U.S.C. §103 in view of Levy et al. and Leonhard et al. (U.S. Patent Publication No. 2002/52933). The rejection is respectfully traversed and reconsideration is requested.

On page 6 of the Office Action, the Examiner acknowledges that Levy et al. does not suggest the use of a Cookie file, and relies upon Leonhard et al. to teach the use of a Cookie to transmit information. The Examiner further asserts on page 6 that one of ordinary skill in the art would use the Cookie of Leonhard et al. to transmit the contents ID of Levy et al. since Leonhard et al. uses a Cookie to get media information with ease over a network, and Levy et al. teaches communicating over a network using a web browser. As additional clarification, the Examiner clarifies on page 10 of the Office Action that, since a Cookie is a commonly used in web browsers and Levy et al. uses a web browser, the use of the Cookie of Leonhard et al. in Levy et al. would have been obvious.

However, it is respectfully submitted that web browsers need not always store data in a Cookie and there is no evidence that such web browsers in all aspects are even required to perform storage at the decoder of Levy et al. Further, there is no evidence that the use of a Cookie of Leonhard et al., when used in the recited context, would actually ease transmission of media from a client to a server system as asserted by the Examiner. Lastly, even assuming temporary storage occurs at a network device during transmission, there is no evidence that

such temporary storage necessarily occurs at the client device as opposed to an intermediary network device, or why such temporary storage should be at a cookie of the sending device.

As noted by the Federal Circuit in In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001), there must be evidence in the record that a claim limitation is met from the prior art in order to sustain an obviousness rejection. In In re Zurko, the Board of Patent Appeals and Interference had upheld an obviousness rejection since the combination was "basic knowledge" and "common sense" to one of ordinary skill in the art. The Federal Circuit overturned the Board's decision by noting that there was no evidence in the prior art disclosing that the combination would have been "basic knowledge" or "common sense," and that the Board "must point to concrete evidence in the record to support these findings." Id. at 1697-98. It is respectfully submitted that, even assuming arguendo that a Cookie is known in the context of browsers, there remains insufficient evidence as to why a Cookie would be used in the context of Levy et al. in a manner required to meet the features of the recited invention.

On page 10 of the Office Action, the Examiner also clarifies that any transmission through a network would require temporary storage at some point. The Examiner also clarifies that, since the ID is stored on a storage medium of Levy et al., the ID would have been stored to the storage medium at some point. However, the Examiner's clarification does not provide evidence as to why the storage would necessarily occur at the decoder of Levy et al. as opposed to an intermediate network device at a hop, or why the storage would have to be in the form of a Cookie created at the decoder as is required to suggest the combination in a manner that meets the claimed invention.

Additionally, assuming arguendo that Levy et al. suggests storing the ID on the storage medium, there remains no evidence as to why the pre-stored ID on the storage medium of Levy et al. would be stored in the decoder of Levy et al., or why one of ordinary skill in the art would necessarily extract and store the ID in the context of a Cookie of Leonhard et al. As such, there remains insufficient evidence as to why one of ordinary skill in the art would modify the transmission of contents ID in Levy et al. by using a Cookie as suggested in Leonhard et al. in order to meet the invention as claimed.

Therefore, it is respectfully submitted that there remains insufficient evidence of a motivation to make the combination as is required to maintain a prima facie obviousness rejection of claim 45 under 35 U.S.C. §103 using Levy et al. and Leonhard et al.

For at least similar reasons, it is respectfully submitted that there is insufficient evidence of a motivation as to why one of ordinary skill in the art would have combined Levy et al. and Leonhard et al. to achieve the invention as set forth in claims 58 and 59 as is required to

maintain a prima facie obviousness rejection under 35 U.S.C. §103.

It is respectfully submitted that there further remains insufficient evidence to maintain a prima facie obviousness rejection under 35 U.S.C. §103 of claims 46-50, 60, and 62-68, which depend from corresponding claims 45 and 59, due at least there being insufficient evidence to maintain a prima facie obviousness rejection of claims 45 and 59.

On pages 8-9 of the Office Action, the Examiner asserts that since Levy et al. returns data associated with the identifier, the returned data is reproduced such that the combination discloses and suggests the recited features of claim 65. However, Levy et al. does not suggest that the contents are not reproduced while the returned data is reproduced. Further, to the extent that col. 4, lines 62-65 of Levy et al. suggests returning data associated with the identifier as set forth in the Office Action, there is no suggestion that the returned data is reproduced without the content data. Since Leonhard et al. is not relied upon as curing this feature and in addition to the patentability of claim 45, it is respectfully submitted that the combination does not disclose or suggest that "the received additional information is reproduced without reproducing the corresponding contents" as recited in claim 65.

For at least similar reasons, it is respectfully submitted that the combination does not disclose or suggest the invention as recited in claim 67

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333. •

Respectfully submitted,

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